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REMARKS

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

**I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 17-20 have been added which incorporates the subject matter of claim 16 into claims 10-13. Claims 1-20 are now pending. No new matter has been added.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

**II. THE REJECTION UNDER 35 U.S.C. § 103(a) ARE OVERCOME**

Claims 1-16 were rejected by the Examiner as allegedly being obvious over Murphy (WO 00/32572) in view of Sheldon ("Catalytic reactions in ionic liquids", *Chem. Commun.*, pp. 2399-2407, (2001)). The applicants' traverse this rejection and request reconsideration of the rejection in view of the following reasons.

All limitations not taught

MPEP 2143.03 states in part that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)". However, even if one of ordinary skill in the art were permitted to ignore considering the references "as a whole" and could simply select isolated elements from the prior art as needed in order to arrive at the applicants' claimed invention, the combination of Murphy and Sheldon still would not teach the applicants claimed invention even in the broadest embodiment as evinced by claim 1.

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The process of preparing organomodified polysiloxanes of claim 1 contains several elements which must be present to be considered part of the process. These elements include:

- (1) reacting a SiH-containing polysiloxane;
- (2) with a compound that contains C-C multiple bonds;
- (3) in the presence of transition metal catalysts; wherein
- (4) the reaction is carried out in the presence of an ionic liquid; and
- (5) after the reaction is complete, the ionic liquid together with the dissolved catalyst is separated from the reaction mixture

Murphy and Sheldon, even when combined, do not teach this simultaneous collection of process elements.

The Examiner acknowledges that Murphy does not teach the use of a SiH-containing polysiloxane for modification which is not surprising given the context of Murphy's teaching, i.e. Murphy teaches a combinatorial process for the discovery of ionic liquids for particular reactions (see page 4, lines 14-17) wherein the "particular reactions" are specifically directed toward the preparation of polyolefins and very high molecular weight polyisobutylenes. Moreover, the evidentiary support for the Examiner's opinion that Murphy would teach the use of a compound which contains a C-C multiple bond is only relevant within the context of Murphy's preparation of polyolefins or polyisobutylenes. There is no teaching or suggestion from within Murphy which would direct one of ordinary skill in the art to conduct hydrosilylation involving a compound with C-C multiple bonds especially in the present instance when there is not even a teaching for use of a SiH-containing polysiloxane.

Although on cursory review the Sheldon reference would appear to be on point, in actuality Sheldon is of little use even for the narrow holding that element (5) is taught. The Sheldon reference does not actually report on any new research but is really a review of the state of the art regarding catalytic reactions in ionic liquids at the time of its publication. For this reason, it is noteworthy that Sheldon does not report on the modification of polysiloxanes (and SiH-containing polysiloxanes in particular). In this regard, Sheldon suffers from the same deficiencies as Murphy, i.e. there is no teaching or suggestion from within the reference which

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would direct one of ordinary skill in the art into the direction of SiH-containing polysiloxanes and further still, to modify such a polysiloxane with a compound containing C-C multiple bonds.

Sheldon does indeed state that "efficient recycling of catalyst is a *conditio sine qua non* for economically and environmentally attractive processes." (see Abstract, page 2399). However, as there is no direction or guidance within Sheldon to modify such a SiH-containing polysiloxane with a compound containing C-C multiple bonds, there is also no teaching of separation step after such a modification.

Additionally, MPEP 2143.02 states in part that "[a] prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. Denied, 469 U.S. 851 (1984)." Here, the Sheldon reference doesn't report that efficient recycling of catalyst is possible even for the unrelated catalytic reactions involving ionic liquids previously known in the art. Whatever general direction Sheldon does provide would appear to be directed toward catalysis in biphasic systems. However, in this regard, Sheldon reports a catalytic scenario for biphasic systems wherein "...the catalyst resides in the ionic liquid *and the substrate/product in the second phase or vice versa.*" (see col. 2, lines 19-21 from the bottom of page 2400). Sheldon also reports that separating the dissolved catalyst is not always possible because of problems with leaching of the catalyst into the product phase and that a derivatization step is first necessary before separation can occur (see col. 1, lines 21-29 of text on page 2402). MPEP 2143.01 states in part that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, (Fed. Cir. 1990)". Here, we have not even established that the references can be combined much less that there is a reasonable expectation for success for such a combination. If there was additional evidence that the Examiner is relying upon to support this rejection (i.e. a taking of official notice), the applicants request that these references be made available to the applicants for consideration in the next office action.

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No motivation to "pick and choose" from amongst the references or to combine the references

Even if Murphy and Sheldon had taught all of the requisite elements of the applicants' invention (or if the Examiner had simply added more references to account for the remaining differences), there is no basis for one of ordinary skill in the art, who is required to consider the references "as a whole" (see MPEP 2141), to "pick and choose" the necessary elements of the applicants' claimed invention for combination.

As stated earlier, Murphy is directed toward a combinatorial method of discovering ionic liquids which by definition encompasses a virtually infinite number of possible permutations from their intended invention. Merely discovering the requisite elements of the invention is insufficient to establish a *prima facie* case of obviousness without a rationale which emanates from the prior art or from the nature of the problem being solved as the determination of obviousness is made by the Examiner who attempts to take the perspective of one of ordinary skill in the art having the cited references before him *but not the applicants' claims to act as a blueprint*. It has previously been held that "...virtually all [inventions] are combinations of old elements...Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' *Sensotronics, Inc. v. Aerasonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996)."

It has previously been held that "*if it is impermissible* within the framework of section 103 to *pick and choose* from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)). Moreover, "[d]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d

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1321, 1329 (Fed. Cir. 1998). There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *ATD Corp.*, 159 F.3d at 546, 48 USPQ2d at 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination."). *Crown Operations Int'l., Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1376, 62 USPQ2d 1917, 1922 (Fed. Cir. 2002).

The vast number of possible permutations given all of the elements described in Murphy resembles the situation found in *In re Rice*, 481 F.2d 1316, 1319, 178 USPQ 478, 480 (CCPA 1973) which concerned a composition with a large number of possible formulations. In reversing the Examiner's rejection, the Court stated "...the board said, referring to the appellant's ingredients, 'It should be noted that an infinite number of combinations is possible.' Accepting that as an approximation to the truth, we fail to see the obviousness in devising appellant's....[invention] as claimed." *Id.* at 480. Likewise, given the infinite number of combinations for the Murphy reference, the applicants fail to see how the present claims are *prima facie* obvious.

Dependent claims are also not taught or suggested by the prior art

As stated earlier, all claim limitations must be met in order to establish a *prima facie* case of obviousness. While the Examiner did not have claims 17-20 before him to consider, claims 2-16 were pending at the time of the first office action. Especially with regard to claims 10-13, the scope of those claims in relation to what the Examiner would like Murphy and Sheldon to teach is similar to that of a genus-species type relationship (see MPEP 2144.08). When reviewing the chart on page 2100-155 of the MPEP (rev. 2, May 2004), it is clear that these claims are non-obvious under §103 especially in light of the arguments made above.

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Accordingly, it is submitted that when one considers all of the teachings in the art, one does not find that all claim limitations have been taught; that there is no motivation to combine the cited references outside the Examiner's own unsupported opinion; that is there any direction from the prior art to partake in the level of "picking and choosing" necessary to approximate the applicants' invention and at the very least that the dependent claims were rendered obvious by the prior art. Reconsideration and withdrawal of the Section 103 rejections are requested.

**REQUEST FOR INTERVIEW**

In the interest of adhering to the tenets of compact prosecution and obtaining good customer service, the applicants request that the teachings of MPEP 707.07(j), sections II and III be applied, especially with regard to the offer of suggestion for correction by the Examiner if the rejections are upheld.

In accordance with MPEP 713.01, section III, should any issue remain as an impediment to allowance, an interview with the Examiner and SPE are respectfully requested; and, the Examiner is additionally requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview ("An interview should normally be arranged for in advance, as by letter, facsimile, electronic mail, telegram or telephone call, in order to insure that the primary examiner and/or the examiner in charge of the application will be present in the office." *Id.*).

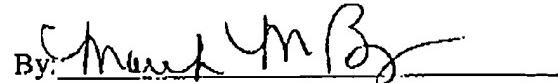
**CONCLUSION**

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

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Respectfully submitted,

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